



FEB 07 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

#24

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Akerman Senterfitt
Las Olas Centre II
350 East Las Olas Boulevard Suite 1600
Fort Lauderdale, FL 33301 4200

In re Application of :
OSTGAARD :
Application No.: 09/486,549 :
PCT No.: PCT/NO98/00232 :
Int. Filing Date: 05 August 1998 : NOTIFICATION
Priority Date: 27 August 1997 :
Attorney Docket No.: None :
For: SAFETY BOX/INCINERATION CONTAINER :
FOR USED SYRINGES :

This notification is in response to the communications filed by applicant on 07 July 2000 and 25 September 2000.

BACKGROUND

On 05 August 1998, applicants filed international application PCT/NO98/00232, which claimed a priority date of 27 August 1997. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 18 March 1999. A Demand for international preliminary examination, in which the United States was elected, was filed on 08 January 1999, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 27 February 2000.

On 25 February 2000, applicants filed a TRANSMITTAL LETTER (FORM PTO-1390) for entry into the national stage in the United States which was accompanied by, *inter alia*, an authorization to charge the U.S. Basic National Fee to Deposit Account No. 50-0951.

On 25 February 2000, applicants filed a second TRANSMITTAL LETTER (Form PTO-1390) for entry into the national stage in the United States which was also accompanied by, *inter alia*, an authorization to charge the U.S. Basic National Fee to Deposit Account No. 50-0951.

On 23 May 2000, the USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form DO/EO/905) indicating, *inter alia*, that the declaration submitted 25 February 2000 did not comply with 37 CFR 1.497(a)-(b) and that thus a

new declaration was required.

On 07 July 2000, applicants submitted a communication stating that “two separate applications” for U.S. patent were filed on 25 February 2000: one in a package having Express Mail Label No. EE683174140US;¹ and the other having Express Mail Label No. EE683174153US.² The communication states that according to the two return post cards for each of these “two respective applications”, both applications have been assigned the same serial no. 09/486,549. The communication then asks for the status and correct serial number for these “two separate patent applications” based on the assumption that the two separate packages could not have been assigned the same serial number.

On 25 September 2000, applicants submitted a response to the NOTIFICATION OF MISSING REQUIREMENTS, which was accompanied by, *inter alia*, a declaration of the inventor.

DISCUSSION

Submission filed 07 July 2000

As noted above, the communication filed 07 July 2000 requests the status and correct serial numbers for the “two separate patent applications” filed 25 February 2000 based on the assumption that the two separate packages filed on that date could not have been assigned the same serial number. However, the assumption is incorrect.

35 U.S.C. 363 states:

An international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office except as otherwise provided in 102(e) of this title. (emphasis added)

Further, 35 U.S.C. 371(b) states:

(b) Subject to subsection (f) of this section, the national stage shall commence with the expiration of the applicable time limit under article 22(1) or (2), or under article 39(1)(a) of the treaty. (emphasis added)

The language of 35 U.S.C. 363 and 371 refers to the national stage of the PCT in the singular only, and thus only one (1) national stage application in the U.S. may develop from an international application. Both Transmittal Letters filed 25 February 2000 indicate that each submission is a “filing under 35 U.S.C. 371” of PCT/NO98/00232. No conflicting instructions

¹The submission filed 07 July 2000 incorrectly identifies this Express Mail Label No. as EEG83174140US.

²The submission filed 07 July 2000 incorrectly identifies this Express Mail Label No. as EEG683174153US.

appear in the application papers. Accordingly, each submission should have been treated as a national stage application submitted under 35 U.S.C. 371 and, in that only one national stage of a PCT application is permitted, it was proper to place both sets of papers in one application file. Additionally, it appears that only one filing fee was charged to Applicant's deposit account for the two submissions filed 25 February 2000.

It is noted that the Annexes accompanying the International Preliminary Examination Report (IPER) for PCT/NO98/00232 have been entered. These Annexes include all of the pages of the specification and claim 1, which is the only claim pending. It is this specification and claim which will be examined.

Although not relevant to the conclusions set forth in this notification, it is noted that: (1) the copy of the postcard listing a Certificate of Express Mail for Express Mail Label No. EE683174153US submitted 07 July 2000 does not have a USPTO date stamp; and (2) both Transmittal Letters filed 25 February 2000 include a Certificate of Express Mail for the same Express Mail Label No.--EE683174140US--, i.e., there is no Certificate of Express Mail for Express Mail Label No. EE683174153US.

Submission filed 25 September 2000

The declaration filed 25 September 2000 complies with 37 CFR 1.497(a)-(b). The surcharge under 37 CFR 1.492(e) (\$65.00 for a small entity) for providing the oath or declaration later than thirty months from the priority date has been charged to Deposit Account No. 50-0951, as authorized in the submission filed 25 September 2000. Accordingly, the requirements under 35 USC 371(c) were satisfied as of that date.

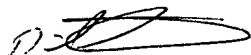
CONCLUSION

For the reasons set forth above, both sets of application papers filed 25 February 2000 have been placed in the file of application number 09/486,549.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the Office of PCT Legal Affairs.

This application is being forwarded to the National Stage Processing Branch of the Office

of PCT Operations to continue national stage processing of the application including: (1) correction of the international filing date to 05 August 2000 (rather than 08 May 2000); and (2) according the application a 35 U.S.C. 371(c) date of 25 September 2000.



Daniel Stemmer
Legal Examiner
Office of PCT Legal Affairs
Telephone: (703) 308-2066
Facsimile: (703) 308-6459



Boris Milef
Legal Examiner
Office of PCT Legal Affairs